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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,769	03/09/2000	Peter C Johnson	99-40165-US	3731

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/18/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/521,769

Applicant(s)

JOHNSON, PETER C

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 10-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413).  
~~Paper No(s)/Mail Date~~ (3 copies)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed 1/30/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

It is acknowledged that the response, filed 1/30/03, has been entered and has overcome the previous rejections of record in a timely manner. The long delay in the mailing of this office action is regretted. However, due to newly found issues as summarized below, this office action reopens prosecution. The finality of the Office action, mailed 9/30/02, is withdrawn due to both the overcoming of the issues therein via the response, filed 1/30/03, and the new issues summarized below.

### **VAGUENESS AND INDEFINITENESS**

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 1, cites the phrase "method for non-random selection of a raw product" in the preamble of the claim which is nowhere repeated or present in any specific claim step in parts (a) – (e) of the claim. It is therefore unclear whether the "non-random" selection practice cited in said preamble controls the metes and bounds of the claim or the actual claim steps (a) – (e) which do not contain any "non-random" limitation therein. It is noted that the above cited phrase is most closely directed to step

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(a) of claim 1 wherein samples of raw product are selected but again as discussed above said step (a) lacks a description of what "non-random selection" is meant or whether this is the step that may correspond to the "non-random selection" practice in said preamble. Clarification via clearer claim wording is requested. This rejection also applies to claims which depend directly or indirectly from claim 1 due to their respective dependencies.

In claim 4, line 3, the abbreviation "MRI" is present which makes the claim vague and indefinite. Such abbreviations may be clarified by inserting the full name in parentheses thereafter, for example, or replacement of the abbreviation via its full name.

### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 5-9 are rejected under 35 U.S.C. 102(b) and (e)(2) as being clearly anticipated by Hasenwinkle (P/N 3,961,654).

It is firstly noted that although plant cultivars are exemplified in the instant specification in the abstract and elsewhere, the limitations of instant claim 1, for

example do not contain any such limitation but rather is generic to a method of raw product selection wherein the raw product is directed to a plant via the phrase "selected plant" in part (a) of said instant claim 1 without even limiting what product from said plant may be practiced in the method of said claim 1.

In Hasenwinkle the selection of raw log products for lumber production is performed, as a primary object of the invention, so as to result in a uniform end product as disclosed in column 3, lines 8-10, as is also the intended object of the practice of the instant invention.

In the reference in column 7, lines 5-25, the sorts of logs are performed for log diameters (a plant phenomics index as in instant claim 5 or macrophenomics as in instant claim 6) prior to the first longitudinal cut. These logs are reasonably interpreted as raw products which have been obtained for performing the sorts and are a product of a selected plant as required in step (a) of instant claim 1. These logs are characterized for the sorting to fall into various diameter classes. The diameter values for these logs are thus analysis results to determine at least one structural index (diameter) as required in step (b) of instant claim 1 which inherently requires analyzing each log sample as to its diameter. Tables in the reference provide a plurality of product processing records which correspond to processing feature range set representative of a uniform quality end product in the reference. Table 1 in column 10 relates the cutting angle to the No. of sectors to be cut which corresponds to a set of log diameter values. Tables II and III in columns 13 and 14, respectively, relate the end product yield to a set of log diameters and corresponding number of Sectors and cut angles. In particular, the

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Sector sizing disclosure in column 9, line 23, through column 10, line 65, relates the log diameter, sector size and corresponding sector cutting angle to the uniform end product of lumber with a standard uniform size. Such a standard uniform size is a 2 X 8 piece having a nominal 1 – ½ inch finished thickness and 7 – ½ inch finished width as disclosed in column 9, lines 24-45. Thus, a plurality of product processing records contains corresponding product processing data (sector values vs. log diameter) which results in a uniform quality end product when applied to a log or raw plant product as required in instant claim 1, step (c). The best cutting pattern is determined for log diameters to obtain the desired lumber type, such as the desired thickness and width from such logs as disclosed in column 11, lines 2-21. Thus the log diameter is disclosed which determines the suitability for the log sample(s) being characterized for processing into the uniform quality end product via the structural or functional index of log diameter as related to sector cutting values which discloses the practice of step (d) of instant claim 1. The last step (e) of instant claim 1 is disclosed in a specific example in the reference in column 12, lines 13-68, wherein a log of a particular diameter is selected which matches a diameter index which then is characterized, when processed, to produce an end product of uniform lumber quality via processing that is related to the structural or functional index (diameter) of the log. In summary, the steps of instant claim 1 are anticipated by said reference. The log index is qualitative in nature as in instant claim 7 due to being a generally cylindrical log as in the first sentence of the abstract. The log diameter index is quantitative as numerically expressed in various Tables as cited above which also reads on the limitation of instant claim 8. The

processing of the logs via cutting, gluing, etc. to make lumber is a type of bioprocessing as in instant claim 9.

Claims 1, 3, and 5-9 are rejected under 35 U.S.C. 102(b) and (e)(2) as being clearly anticipated by Einarson et al. (P/N 4,806,014).

It is firstly noted that although plant cultivars are exemplified in the instant specification in the abstract and elsewhere, the limitations of instant claim 1, for example do not contain any such limitation but rather is generic to a method of raw product selection wherein the raw product is directed to a plant via the phrase "selected plant" in part (a) of said instant claim 1 without even limiting what product from said plant may be practiced in the method of said claim 1.

In Einarson et al. in column 1, lines 26-41, the goal of the invention therein is summarized as being directed to controlling the raw materials in a pulp manufacturing process so as to result in reduced process disturbances and for variations in product quality. This reduction in variations of product quality is also the aim of the instant invention which is reasonably interpreted as the goal of a "uniform quality end product" which is the last few words of instant claim 1. Various imaging method steps (as also required in instant claim 3) are set forth in the reference such as light exposure with size distribution information of obtained for chip samples as set forth in the reference in column 2, lines 14-29. Another imaging practice in the reference is via camera usage as disclosed in column 2, line 68, through column 3, line 41, wherein raw product indices are determined such as length, thickness, area, etc. as listed in column 3, lines 32-36, as well as in parts (a) and (b) of instant claim 1. The acceptable raw material

indices as correlated for various chip indices are set forth in column 1, lines 50-62, which are both previously set forth uniform end product indices corresponding to raw materials and also utilized in the invention of the reference. This connection between these previously utilized index/processing acceptability data sets and the camera or imaging steps of the invention of the reference is described in column 4, line 57, through column 5, line 6, which describes the optical measurement as being well suited for measurement on-line as utilized in the reference as well as in part (c) of instant claim 1. The suitability and selection of raw products as in steps (d) and (e) of instant claim 1 as the final outcome of the process of the reference is set forth in the summary of such manufacturing in column 1, lines 26-62. where acceptable chips are determined as selected as generally is the goal of the invention of the reference. The limitations of instant claims 5-9 are met by the reference similar to in the above rejection in that macrophenomics are being evaluated either quantitatively (sizes in column 3, lines 31-36, of the reference) or qualitatively (texture in column 3, lines 31-36 of the reference) for bioprocessing of wood chips.

### **INFORMALITIES**

The disclosure is objected to because of the following informalities:

In the specification in the BRIEF DESCRIPTION OF THE DRAWINGS on pages 10-11, several drawing parts are not separately described. During the issuance process, an issue is frequently raised that such parts must be separately described. Such parts that need separate description are Figures 1A, 1B, 3A, 3B, 3C, 3D, and 3E.



It is noted that the specification refers to Figure 1 or 3, for example, at pages 12, line 13, and page 24, line 17, respectively, but without differentiating the parts thereof. Confusingly, in contrast, Figures 4A and 4B are separately discussed on page 26, line 19.

Appropriate correction is required.

No claim is allowed.


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571)272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571)272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571)272-0549 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 11, 2004

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER